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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,915	01/10/2001	Jay Stone	30020-pa	8320

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EXAMINER

RADA, ALEX P

ART UNIT PAPER NUMBER

3714

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/757,915

Applicant(s)

STONE, JAY

Examiner

Alex P. Rada

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,6-13 and 15-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,6-13 and 15-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

In response to the amendment filed August 14, 2002, in which the applicant has cancelled claims 2, 4, 5, and 14, amends claims 1, 7, 10, 11, 15, and 16, adds new claims 17-22, and claims 1, 3, 6-13, and 15-22 are pending in this application.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a) because they fail to show symbols (20), paylines (22), and matrix (21) on page 10 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the output is first examined for its presence on the payable and if there is no match another comparison takes place and the movable output features are engaged of claims 1, 7, 10, 11, 15, 16, 19, 20, 22, the definite language (i.e. "only if", "if and only if", and "initial" language) of claims 1, 3, 6-13, and 15-22, and the alternative second outcomes of claim 21 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 3, 6-13, and 15-22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not disclose the output is first examined for its presence on the payable and if there is no match another comparison takes place and the movable output features are engaged. The examiner request the applicant to point out in the specification the particular subject matter as stated above.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 recites the limitation "alternative second outcomes" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 6-13, and 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bessho '169 in view of Arnold (GB) '781.

9. Bessho discloses a display (3), a plurality of decision making means (figure 2), a wagering means (figure 2), a processor including a random means (figure), a display for including a plurality of symbols oriented in an RXC matrix (figure 1), and a processor including means to change the location of one or more symbol if the first outcome is not recognized by the payable such that the one or more symbols move from their first outcome orientation to a different area in the RXC matrix to provide a second outcome recognized by the comparison means to be on the table (column 1, line 66 – column 4, line 67) as recited in claims 1, 15, 16, 19, 20, and 22. The symbols only move from the first outcome orientation to an area within the same row or column, subset, and one specific column of the matrix (column 1, line 66 – column 4, line 67) as recited in claims 3, 6, 7, and 21. The number of predetermined number of symbols necessary for a winning outcome and recognized by the payable (column 1, line 66 – column 4, line 67) as recited in claims 8 and 9. The outcome is recognized by the highest-ranking and lowest-ranking combination on the payable of possible combinations of symbols of the first outcome orientation (column 1, line 66 – column 4, line 67) as recited in claims 11 and 12. The location of one or more symbol is not recognized by the payable is active during all times of operation and not active during all times of operation (column 1, line 66 – column 4, line 67) as recited in claims 12 and 13. Bessho does not expressly disclose a means to bestow an award if the first outcome is recognized on the payable as recited in claims 1, 15, 16, 19, 20, and 22.

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Arnold teaches a fruit machine having the equivalent means to award if the first outcome is recognized on the payable (column 2, line 106 – column 3, line 27). By having a means to award if the first outcome is recognized on the payable, one of ordinary skill in the art would be able to give game players a second chance at an outcome. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention was made to modify Bessho to include a means to bestow an award if the first outcome is recognized on the payable as taught by Arnold. To do so would be able to give game players a second chance at a bigger payout.

Regarding claims 17 and 18, the particular indicia used is a matter of design choice, wherein no stated problem is solved, or unexpected result obtained, by using the specific indicia claimed versus the indicia taught by the prior art.

Response to Arguments

10. Applicant's arguments with respect to claims 1, 3, 6-13, and 15-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

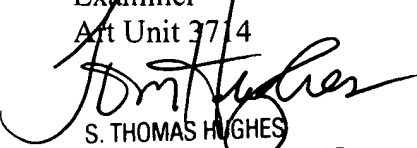
Wain, (GB) '797 discloses a coin-operated entertainment machine having display regions at which are provide at the end of a game a combination of fixed visual display (A, B, C) the aim being for a player to try to obtain a winning combination.

Sakamoto '663 discloses a game machine having a plurality of cylindrical reels each provided with various kinds of symbols on its outer surface.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 703-308-7135. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

APR
apr
October 16, 2002

Alex P. Rada
Examiner
Art Unit 3714

S. THOMAS HUGHES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700